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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/783,096	02/15/2001	Kazuhiro Kusuda	Q63180	4487

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SUGHRUE, MION, ZINN, MACPEAK & SEAS, PLLC  
2100 Pennsylvania Avenue, N.W.  
Washington, DC 20037

EXAMINER

COBURN, CORBETT B

ART UNIT PAPER NUMBER

3714

DATE MAILED: 03/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	<b>Application No.</b> 09/783,096	<b>Applicant(s)</b> KUSUDA, KAZUHIRO	
	<b>Examiner</b> Corbett B. Coburn	<b>Art Unit</b> 3714	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 January 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4, 6, 8-11, 13, 15-18 and 20-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6, 8-11, 13, 15-18 and 20-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 February 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-4, 6, 8-11, 13, 15-18, 20, 22 & 24-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fongeallaz in view of Filiczkowski (US Patent Number 5,106,098) and Nakagawa, et al. (EP 0757917).

**Claims 1, 8, 15:** Fongeallaz teaches a computerized game system with a racing field formed on a predetermined board (Fig 13) that is electronically displayed on a screen. There is a running model to which an inherent ability parameter varying in accordance with a given environment is assigned. (Col 5, 41-45) The racing field (Fig 13) comprises a plurality of tracks (L1-L16) in which the running model runs based on a current ability parameter in accordance with the respective track. (Col 5, 40-56) These tracks clearly exist concurrently on the same game board. (Fig 13) Fongeallaz does not specifically teach independent tracks. Filiczkowski teaches independent tracks (abstract), i.e., a dirt track and a turf track (Fig 1B). The ability parameter is changed according to the movement of the running model from one of the plurality of tracks to another of the plurality of tracks. The horse runs on a dirt track when running on the outside track and a turf track when running on the inner track. Filiczkowski teaches that this allows the

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invention to closely simulate actual horse race track action. (Abstract) It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Fongeallaz track in view of Filiczkowski's teachings to include independent tracks (i.e., a dirt track and a turf track) in order to simulate actual horse track action.

Filiczkowski teaches that the physical running models that can run races on both tracks. (Abstract) The starting posts are essentially passageways formed between the plurality of concurrently existing tracks so that the running models can enter the tracks. The finish lines are essentially passageways formed between the plurality of concurrently existing tracks so that the running models can exit the tracks. They are not, however, physical passageways for use by physical running models. Nakagawa teaches physical passageways for use by physical running models. (Page 6, 33-36) Physical models are well-known to attract players. Physical models demand physical passageways – they have to have some manner of moving around on the playing surface. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Fongeallaz and Filiczkowski and Nakagawa to have physical passageways for use by physical running models in order to facilitate movement of the physical running models (which attract players) on the game board.

**Claims 2, 3, 9, 10, 16, 17:** Fongeallaz teaches the invention substantially as claimed.

Fongeallaz teaches use of a track with regions having different attributes. (Col 5, 40-62)

For instance, Fongeallaz suggests use of dry track and mud track attributes. (Col 5, 43-45) Fongeallaz describes a steeplechase game in which there are flat regions where the running model performs steady running in which the current ability parameter is

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maximized and in other regions there is a region formed so as to obstruct the steady running (obstacles). (Col 5, 63-66) Fongeallaz fails to explicitly teach entire tracks where the current ability parameter of the running model is maximized or minimized. Filiczkowski teaches a dirt track and a turf track (Fig 1B) where the current ability parameter of the running model is maximized or minimized. Filiczkowski teaches that this allows the invention to closely simulate actual horse race track action. (Abstract) It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Fongeallaz track in view of Filiczkowski's teachings to include a dirt track and a turf track where the current ability parameter of the running model is maximized or minimized in order to simulate actual horse track action.

**Claims 6, 13, 20:** Fongeallaz teaches the plurality of tracks form concentric racing courses. (Col 4, 36-43) Filiczkowski's Fig 1 B shows the plurality of tracks form concentric racing courses.

**Claims 4, 11, 18, 22:** Fongeallaz teaches the invention substantially as claimed. Fongeallaz teaches use of a track with regions having different attributes. (Col 5, 40-62) For instance, Fongeallaz suggests use of dry track and mud track attributes. (Col 5, 43-45) While Fongeallaz does not specifically teach dirt and turf track sections, these are the two main types of tracks used in horseracing. Filiczkowski teaches a dirt track and a turf track. Filiczkowski teaches that this allows the invention to closely simulate actual horse race track action. (Abstract) It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Fongeallaz track in view of

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Filiczkowski's teachings to include a dirt track and a turf track in order to simulate actual horse track action.

**Claims 24-26:** Filiczkowski clearly teaches that each track has a different surface. The horse runs on a dirt track when running on the outside track and a turf track when running on the inner track. (Col 2, 60-61)

3. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fongeallaz, Filiczkowski and Nakagawa as applied to claim 22 above, and further in view of Ikeda et al. (US Patent Number 6,371,854).

**Claims 23:** Fongeallaz, Filiczkowski and Nakagawa teach the invention substantially as claimed. Fongeallaz teaches storing a "library" of data concerning the attributes and abilities of each running model. (Col 5, 50-62) Fongeallaz does not, however, specifically teach adding a game value to the "library" in accordance with the result of the race. Ikeda, a game in the same art, teaches allowing players to raise and train their own horses (running models). This training includes running races and recording the result of the race in the horse's library of information. Allowing players to raise and train their own horse gives the player a greater sense of involvement in the game. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the Fongeallaz's library by add a game value to the horse's "library" of attributes in accordance with the result of the race as taught by Ikeda in order to allow the player to raise and train the horse, thus giving the player a greater sense of involvement in the game.

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***Response to Arguments***

4. Applicant's arguments filed 18 January 2005 have been fully considered but they are not persuasive.

5. Applicant's arguments are drawn to the claims as amended and are addressed in the rejection above.

6. Applicant argues that Nakagawa fails to teach a physical gate between two concentric tracks. Examiner does not rely on Nakagawa for the teaching of two concentric tracks.

Nakagawa teaches use of a physical gate to provide a passageway for physical running models between two areas in a racing game. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

***Conclusion***

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Corbett B. Coburn whose telephone number is (571) 272-4447.

The examiner can normally be reached on 8-5:30, Monday-Friday, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's <sup>primary</sup>~~supervisor~~, Jessica Harrison can be reached on (571) 272-4449. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



cbc



JESSICA HARRISON  
PRIMARY EXAMINER